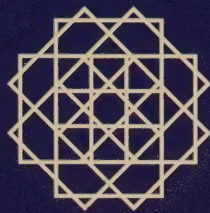
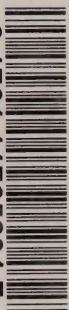


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A GUIDE TO TRADE-MARKS

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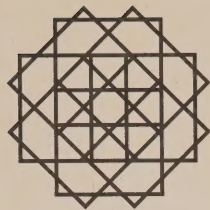
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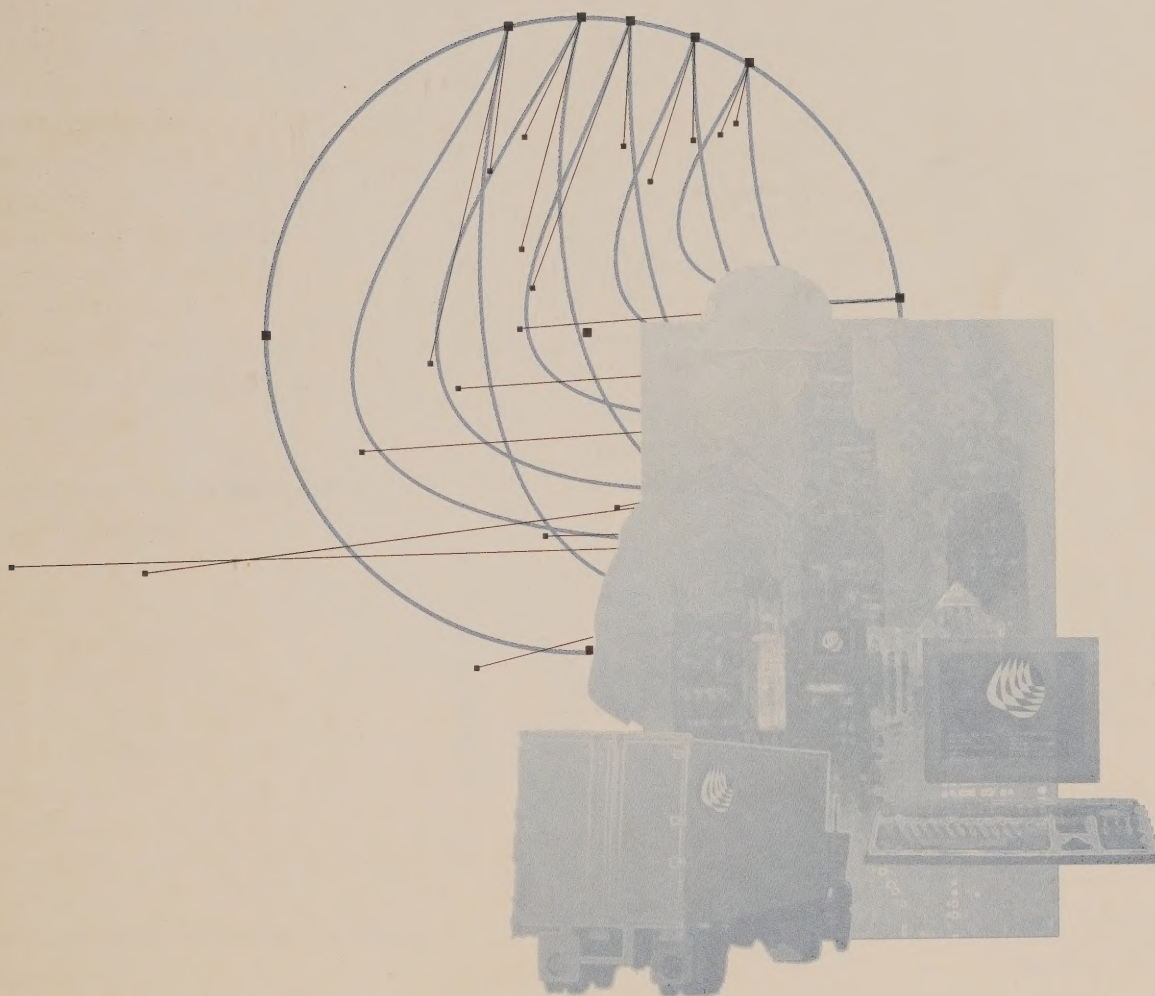
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A GUIDE TO TRADE-MARKS



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Your identity in the marketplace

Success in the business world depends largely on the message you convey and the image you project. This was the case 50 years ago and is even more true in the competitive global marketplace of the 1990s. You may have an excellent product or service to offer, but if people can't pick you out easily in the crowd, you'll probably be overlooked in favour of a firm with a stronger presence.

It's no coincidence that certain brand names that dominated the North American market in the 1920s still are leaders today. The public gravitates towards familiar names and symbols that have become associated with quality and reliability. That's why companies spend millions of dollars nurturing their corporate images. They may research, design, market and protect a name, logo or package design as much as the physical product itself.

A key way of protecting your corporate identity is through a registered trade-mark. Registration of your trade-mark is legal title to intellectual property in much the same way as a deed is title to a piece of real estate. It verifies the exclusive right you have established through use of a word, symbol, style or combination of these (a more complete definition follows under the heading "What is a trade-mark?"). Whether you are just starting out on a business

venture or have been in the field for a long time, it pays to know about trade-marks. It's part of working strategically in a fast-paced world.

Purpose of this guide

In this booklet we will look at what trade-marks are, how they can benefit you and how to register one. With a basic knowledge of the trade-mark concept and process, you can take steps to protect your intellectual property and avoid infringing the rights of others. This may help you steer clear of costly and time-consuming legal battles.

Keep in mind that this booklet offers general information only and does not cover all the complex issues that may arise through the registration process. This guide is not a substitute for an experienced trade-mark agent. Nor does it provide authoritative definitions and explanations, for which the reader is referred to the *Trade-marks Act*, the *Trade-marks Regulations* and decisions of the Trade-marks Office Opposition Board and the courts. However, even if you are hiring a registered trade-mark agent, this guide can help you become a well-informed client.

Consult the Act, the Trade-marks Office or a registered trade-mark agent for more detailed information.

The Canadian Trade-marks Office

The federal agency responsible for registering trade-marks in Canada is the Trade-marks Office, directed by the Registrar of Trade-marks.

The Trade-marks Office is part of a larger agency called the Canadian Intellectual Property Office (CIPO), which is part of Consumer and Corporate Affairs Canada, the federal department responsible for promoting the fair and efficient operation of the marketplace. CIPO is responsible for other forms of intellectual property as well, namely, patents, copyrights, industrial designs and integrated circuit topographies.

The main functions of the Trade-marks Office are to:

- receive and examine applications for trade-mark registration and grant registrations to qualifying applicants;
- record and index registrations of trade-marks;
- receive and examine applications for registered users of trade-marks;
- grant registrations to qualifying registered users;
- approve and record assignments of trade-mark applications;
- maintain records of trade-mark registrations and pending marks and a search room of these records for public use;
- provide general information to the public about the trade-mark registration process; and
- publish the *Trade-marks Journal*.

What is a trade-mark?

A trade-mark is a word, a symbol, a design, or a combination of these, used to distinguish the wares or services of one person or organization from those of others in the marketplace. Trade-marks come to represent not only actual wares and services, but the reputation of the producer. As such, they are considered valuable intellectual property. A registered trade-mark can be protected through legal proceedings from misuse and imitation.

There are three basic categories of trade-marks:

1 Ordinary marks are words or symbols that distinguish the wares or services of a specific firm or individual. Suppose you opened a courier business which you called "Giddy-up." You could register the words as a trade-mark (assuming all legal requirements were met) for the service you offer.

2 Certification marks identify wares or services which meet a defined standard. They are owned by one person but licensed to others to identify wares or services which meet a defined standard. Examples are: the Wool Mark owned by The Wool Bureau of Canada Limited for use on clothing and other wares and the logo of the Association of Professional Engineers.

3 Distinguishing guise identifies the unique shape of a product or its package. If you manufactured candy moulded to look like

butterflies, you might want to register the butterfly shape as a trade-mark under "distinguishing guise."

Other forms of intellectual property

People occasionally confuse trade-marks with copyright, industrial designs, patents and integrated circuit topographies. These are rights granted for intellectual creativity and are also forms of intellectual property. However:

- patents are for new technologies (process, structure and function) and, in certain circumstances, patent protection also may be available for computer software;
- copyright is for literary, artistic, dramatic or musical works and computer software;
- industrial designs are for the shape, pattern or ornamentation applied to an industrially produced object;
- integrated circuit topographies refer to the three-dimensional configuration of the electronic circuits embodied in integrated circuit products or layout designs.

Trade name vs. trade-mark

A trade name is the name under which you conduct your business, whether it be your own name, or the name of a corporation or a partnership or a name adopted for a segment of that business, i.e. a division of a

company. The trade name can be registered under the *Trade-marks Act* only if it is also used as a trade-mark, that is, used to identify wares or services.

For instance, let's say you own an ice cream business and your company is called A.B.C. Ltd.:

Example 1 — People know your ice cream under the name A.B.C., because you use it as a trade-mark on or in association with your ice cream. You can, therefore, register A.B.C. as a trade-mark.

Example 2 — People know your ice cream under the word you have promoted — for example, "Northpole." Even though the official name of your company is A.B.C. Ltd., no one associates it with your wares. Therefore, A.B.C. cannot be considered a trade-mark unless you begin to use it as one.

In certain circumstances, a trade-mark registration may be declared invalid because of the prior use in Canada of a trade name which is similar to the registered mark. Ideally, you should conduct a search of existing trade names before filing a trade-mark application. To do this, you can consult a variety of sources, including the NUANS (Newly Updated Automatic Name Search) database maintained by the Department or even telephone directories from cities across the country. To ensure a thorough search, it is best to hire a trade-mark agent to do the job.

Registered trade-mark vs. unregistered trade-mark

A registered trade-mark is one that is entered on the Trade-mark Register held by the Department of Consumer and Corporate Affairs in Hull, Quebec. You are not required to register your trade-mark — using a mark for a certain length of time can establish your ownership through Common Law — but it is highly recommended. You must, however, apply for registration of a mark for precious metals. Your filing receipt is necessary if your goods must pass through customs.

Registration of your trade-mark gives you the exclusive right to use the mark across Canada for 15 years, renewable every 15 years thereafter. You'll have to apply for foreign registration if you want protection in other countries. Registration is direct (*prima facie*) evidence of your ownership and enables you to more easily protect your rights, should someone challenge them. In a dispute, the registered owner does not have to prove ownership; the onus is on the challenger. Use of an unregistered trade-mark can lead to a lengthy, expensive legal dispute over who has the right to use it. Keep in mind also that a registered trade-mark is a valuable asset for business expansion through licensing franchises. Note as well that if you fail to use the mark for an extended period, your registration may be cancelled.

Consider this scenario: For the past five years you've been operating a highly successful ice cream emporium under the word "Northpole" in your home town in Nova Scotia. You've never heard of another Northpole and you have never bothered with trade-mark registration.

Meanwhile, an Ontario firm has registered the trade-mark "Northpole" to identify its growing chain of spaghetti diners and home brand tomato sauce. While conducting research for a Maritime expansion plan, the Ontario firm discovers your store and serves you with a lawsuit. Depending on the facts established with the Court, this may result in a court order preventing you from using the word "Northpole." This development couldn't come at a worse time, since you were just planning to expand your own business. The situation could have been avoided if you had solidified your clear rights to the trade-mark through registration.

Trade-mark agents

Preparing a trade-mark application and following through on it can be a complex task, particularly if a rival challenges your right to the mark. You may file on your own, but it is highly recommended that you hire a registered trade-mark agent to do so on your behalf. There are two kinds of registered agents: 1) lawyers or, in the Province of Quebec, notaries who have paid the prescribed fee to register with

the Trade-marks Office; and 2) persons who have worked in the field of trade-mark applications for at least two years under the supervision of a registered agent and have passed a rigorous qualifying examination in the field.

An experienced, competent trade-mark agent who is well-briefed can save you problems caused by such obstacles as a poorly-prepared application or inadequate research. If you intend to register marks in other countries, the use of a trade-mark agent is strongly recommended.

The Trade-marks Office can provide you with a list of registered agents, but cannot recommend any particular one to you. Your local telephone directory is another source of agents' names.

Once you've appointed an agent, the Trade-marks Office will correspond with no one else about your application. You may, however, change agents at any time.

Who can register a trade-mark?

Companies, individuals, partnerships, trade unions and lawful associations may obtain registration of their marks of identification for wares or services, provided they meet the requirements of the *Trade-marks Act and Regulations*.

How do I register my trade-mark?

You register a trade-mark by filing an application for registration with the Trade-marks Office in Hull, Quebec. Your application then goes through a stringent examination process to make sure that it meets all requirements of the *Trade-marks Act*. Keep in mind that in most instances your trade-mark must be used in Canada before it can be registered. While your application may be based on “proposed use,” you must put your trade-mark into use before registration can occur.

In the following pages, we will outline the steps towards registration.

How much does it cost?

The basic federal government costs are:

- \$150 (non-refundable) for each trade-mark applied for;
- \$200 for a certificate of registration, if your application is successful; and
- an extra \$50 if your application is incomplete and you have to add documents to it.

These costs do not take into account the fees of an agent, if you are using one.

Five-step examination process

When the Trade-marks Office receives your application, it does the following:

- 1** searches the trade-marks records to find any other trade-mark that may come into conflict with the one you've submitted and, if one is found, informs you of it;
- 2** examines the application for compliance with the requirements of the *Trade-marks Act* and *Regulations* and informs you of requirements which are not met by the application;
- 3** publishes the application in the *Trade-marks Journal*, which is issued every Wednesday;
- 4** allows time for opposition (challenges) to the application. Anyone may, upon payment of \$250, file a statement of opposition with the Registrar. After considering the evidence filed by either or both parties, the Registrar decides whether to refuse your application or reject the opposition. The parties are notified of the decision and reasons why;
- 5** if no one files an opposition to your application, the mark is allowed. Upon payment of the \$200 registration fee and the filing of a declaration of use in the case of a proposed use trade-mark application, your mark is registered.

How long does registration last?

Your registration is valid for 15 years, and you can renew the registration every 15 years thereafter upon payment of a renewal fee.

Foreign registration

Registering your trade-mark with the Canadian Trade-marks Office protects your rights in Canada only. If you are selling wares or services in other countries, you should consider registration in each of those countries. Contact a trade-mark agent or the embassy of the country in question for information on foreign registration.

Your trade-mark will qualify for registration as long as it does not conflict with Canada's *Trade-marks Act*, which sets out the requirements for registration. Sections 9 through 12 of the Act deal with the kinds of marks you may not register. Become familiar with these restrictions, summarized below. It will help ensure a successful application.

Names and surnames

A trade-mark will not be registered if the trade-mark is primarily your full name or surname, or that of another individual (e.g. John Doe or Jane Smith, Wong, Cohen, etc.). An exception to this rule is if you can prove that your wares or services have become known under the name "Smith" or "Wong" or "Cohen," so that the word now connotes more than a person's name or surname in the public's mind. There are numerous examples of personal names that have become associated with a food, drink, or other product and are now registered trade-marks.

Another exception is if the name or surname has meaning other than just as a name or surname, i.e. it is also a recognizable word. Suppose your last name were, in fact, "Brown." You could register the word for your ice cream business as long as there were no other reasons to disqualify it.

Clearly descriptive

You may not register a word that clearly describes a feature of the wares or services. For example, "sweet" for ice cream, "juicy" for apples, and "perfectly clean" for dry cleaner services could not become registered trade-marks. All good apples could be described as "juicy" and all ice cream as "sweet"; these are inherent characteristics of the wares. If you were allowed to register these words, no other apple sellers or ice cream vendors could use them to promote their goods, which would be unfair. Again, if you can establish that "Sweet Ice Cream" has become so well known that people think of your product (and no one else's) when they hear the words, you might be able to register the trade-mark.

Deceptively misdescriptive

A further restriction is if the mark is not clearly descriptive, but clearly misleading, or in the words of the Act, "deceptively misdescriptive." For example, you could not register "sugar sweet" for candy sweetened with artificial sweetener, and "air express" for a courier service that uses ground transportation.

Place of origin

You may not register a word that clearly designates the place of origin of the wares or services, or that misleads the public into thinking that the wares come from a certain place if they do not. Thus, Paris Fashions, Atlantic Cod, Toronto Courier Service, B.C. Wines, or Danish Furniture could not be registered for those particular wares and services. Allowing you to use place names as part of your trade-mark would be to give you a monopoly on a geographical term and be unfair to others. However, you conceivably could register the words "North Pole" for bananas, since no one would expect bananas to come from there.

Disclaimers

A disclaimer is a statement indicating that a certain word or portion of a trade-mark is not protected. In this way, you can use a generic word in your mark with the understanding that you have no monopoly over it. For example, for Northpole Ice Cream, a disclaimer would cover the words "ice cream."

Having a disclaimer does not mean you can never use the disclaimed portion as part of your trade-mark. If, at a later date, you can demonstrate the disclaimed matter has become distinctive of your wares or services, you may be able to register it.

Words in other languages

Words that constitute the name of the wares or service in another language — such as “gelato,” Italian for ice cream; “anorak,” Inuktitut for parka; or “Wurst,” German for sausage — could not be registered.

Causing confusion

Beware of words, symbols, sounds and ideas that suggest someone else’s trade-mark. If it is confusingly similar to a registered trade-mark or a pending mark, it will be refused. This prohibition makes sense when you recall that the whole point of registering a trade-mark is to protect your corporate identity from imitation or confusion with others. Trade-mark examiners take into account various factors when determining whether trade-marks are confusing. For example, they determine:

- A** whether the trade-marks look or sound alike and whether they suggest similar ideas; and
- B** whether they are used to market similar wares or services.

Let’s go back to the example of “Northpole” Ice Cream. Suppose another company was manufacturing and selling frozen water products under the registered trade-mark “Southpole.” People might easily conclude that “Northpole” and “Southpole” products are manufactured and sold by the same company. They might expect the trade-marks to be owned by the same entity.

Hence your application to register “Northpole” might be turned down on the grounds of causing confusion with the registered mark “Southpole” owned by another company.

Other hypothetical examples of confusing trade-marks would be: “King Dog Food” vs. “King Cat Food” (two companies, two different product lines, but the same trade-mark and the same general area — pet food); and “Glitter” mineral water vs. “Glittering” ginger ale. However, “Glitter” for mineral water could probably co-exist as a registered trade-mark with “Glittering Dry Cleaners” as a registered trade-mark for dry cleaning services, because the wares and services in this example are quite different.

Prohibited marks

Section 9(1) of the *Trade-marks Act* lists various kinds of marks that are expressly prohibited. You may not register a trade-mark that resembles certain official symbols unless you have the consent of the authority in question. These official symbols include:

- official government symbols, e.g. the Canadian flag;
- coats of arms of the Royal Family;
- badges and crests of the Armed Forces and the R.C.M.P.;
- emblems and names of the Red Cross, the Red Crescent, the United Nations;

- flags and symbols of other countries; and
- symbols of provinces, municipalities and public institutions.

These prohibitions are designed to prevent people from “cashing in” on the prestige and authority of the above-mentioned institutions and misleading the public.

Section 9(1) of the *Trade-marks Act* also prohibits subject matter that is obscene or immoral. For example, your trade-mark may not include profane language, obscene visuals or racial slurs, or promote illegal substances.

Another prohibition covers the use of portraits or signatures of living persons or persons who have died within the preceding 30 years. For example, using the photo of an existing rock group to promote your record store would be prohibited unless you had formal consent to do so.

Summary: What trade-marks can you register?

No:

- “Sweet” Ice Cream
- “Devonshire” Ice Cream
(unless, in the above cases, you can prove that the trade-mark is distinctive of the applicant)
- “Northpole” Ice Cream
(if “Southpole” is a registered trade-mark for frozen water products)
- “R.C.M.P.’s Favorite” Ice Cream

Yes:

- “Northpole” Ice Cream (if it is not confusing with a registered or entitled pending trade-mark — i.e. one with an earlier date of use or filing)
- “Venus” Ice Cream (mythical, not actual name)
- “Scrumptillus” Ice Cream
(invented, not real adjective)
- “True Blue” Ice Cream (words not normally associated with ice cream)
- “Garden of Eden” Ice Cream
(mythical, not actual place)

Note: In all the above cases, there would be a disclaimer covering the words “ice cream.”

The preliminary search

The Trade-marks Office

The Trade-marks Office maintains a public inventory of all registered trade-marks and pending applications at its premises in Hull, Quebec. The Trade-marks Office has also developed an electronic database of all word marks (design marks will be included in the future) and various companies are licensed to access the database. Before you apply for trade-mark registration, you or your agent should conduct a thorough search of these records to see if your trade-mark could be confused with someone else's. This step is not mandatory, but it is a good idea for two reasons:

1 It is a form of pre-screening. It will help you determine whether your application has a chance for success, or whether it would be a waste of time and money to try to register it in its present form. For example, your search may turn up a registered trade-mark "Southpole" for frozen water products, hence you would have trouble registering "Northpole" for your ice cream. You might, at this stage, want to consider modifying your trade-mark to add or adopt more original words or artwork.

2 A search can help you avoid trade-mark infringement and potential lawsuits.

The search room in Hull is open to the public, free of charge, from 8:30 a.m. to 4:45 p.m., Eastern Time, Monday through Friday, except on legal holidays, at:

50 Victoria Street
Place du Portage Phase I
2nd Floor
Hull, Quebec

You may personally visit the Trade-marks Office, or you may consult one of the companies licensed to use the electronic database, or hire a freelance trade-mark searcher or a registered trade-mark agent to do the research job on your behalf. Freelance searchers and trade-mark agents are listed in your local telephone directory.

The Trade-marks Office inventory contains listings of some 350 000 registered and 55 000 pending trade-marks. Indexes cover word marks, slogans, numbers, pictures and combinations of these. As soon as your application is officially accepted, it too becomes part of the public record and is subject to inspection by other applicants.

To conduct a proper search, you will have to check for various possible versions of the mark. In the case of a word mark, you should look for all conceivable spellings. For example, if your trade-mark is "Northpole," you search for "North," "Nord" and "Pole".

Also in the Office records are samples of crests, badges and official symbols that fall into the category "Prohibited Marks," under section 9(1) of the *Trade-marks Act*. These samples can help you verify that your trade-mark does not fall into a prohibited category.

You should allow at least half a day to conduct your search. An information officer in the Search Room will be pleased to explain how the indexes work and to give you general information about the *Trade-marks Act* and *Regulations*. Remember, the Trade-marks Office cannot conduct the search for you, or advise you on whether your mark is registrable. This can only happen in the examination process for a filed trade-mark application.

Trade Names

Consider also having a search of trade names done before you go any further. Trade names (as discussed previously) are often also used as trade-marks, even if they are not registered as such. Southpole Inc. may never have filed for trade-mark registration, but if the name "Southpole" is known for frozen water products, the company could argue ownership of the word as a trade name, as well as a trade-mark. Southpole Inc. could not prevent you from filing your "Northpole" application. The Trade-marks Office would not have "Southpole" on its trade-mark records, because trade names are not registered with it.

However, Southpole Inc. could easily find out about your application, either by doing a search of the Trade-marks Office records or when your application is published in the *Trade-marks Journal*. It may then challenge your application during the stage called "Opposition."

As trade names may be recorded separately in each province under provincial legislation, there is no complete central inventory containing all current names, although through NUANS you can access a database of registered corporate names. This search is therefore quite complex and you are advised to hire a trade-mark agent to do the job for you.

Application

The principal document in the registration process is your application form. You must file a separate application for each trade-mark you wish to register, although one application may cover both wares and services or a number of wares or services.

You create the form yourself based on the sample formats supplied with this guide. There are a total of 13 different formats, covering every kind of application (e.g. ordinary marks, certification marks, applications for amendment of a registration, applications to be a registered user, etc.). For your convenience, the most commonly used formats, 1 and 4, annotated with

instructions for filling them out, are included as Appendix B.

■ Format 1 is for applications for ordinary marks based on use in Canada. This means you have been using the mark for a certain length of time and your claim is based on this fact.

■ Format 4 is for applications for ordinary marks based on proposed use in Canada. This means that you state your intention to use the mark as described in your application. (You must demonstrate "use" before registration can occur.) You should consider waiting until the opposition period is over before commencing use of your mark.

If appropriate, you could combine the two formats. For example, if you've been offering a restaurant service under the name "Northpole" for several years and now you plan to also sell "Northpole" ice cream, your application would be based on both "use for the services" and "proposed use for the wares."

Whichever format you use, you must specify the trade-mark you are seeking to register. If your trade-mark is anything other than a word or words in block letters, then four drawings of the design are required at the time you file the application. The four formal drawings should:

- be in black and white;
- be on a piece of paper not exceeding 2 3/4 inches by 2 3/4 inches; and

■ include a description of the colour(s) if colour is claimed by you in the trade-mark.

If you wish, you may use the special chart in the *Trade-marks Regulations* to indicate your colours. But note that including colour gives you less flexibility, as you must then always use your trade-mark in those specified colours. If you simply present your design in black and white, you will be free to use the mark in any colour. Likewise, presenting your word mark in any style of lettering other than plain capital letters restricts you. If you wish maximum flexibility, present the word mark in plain capital letters and the design in black and white.

If your design is based on "use in Canada," then three specimens of the mark as used should be submitted at the time of filing. The specimens can be labels, containers (flattened) or displays, showing the mark as it is actually being used. Remember, if you do not fulfil these requirements, you will have to pay an additional \$50 fee for completing your application.

To sum up, a complete application includes:

- 1 the appropriate application form filled out by you or your agent;
- 2 your written authorization if someone other than you or your agent has signed the application;
- 3 the application fee; and
- 4 any required formal drawings and/or specimens, where appropriate.

Filing date

When your application arrives at the Trade-marks Office, the Office staff check it to make sure it is complete. If anything is missing, they will write you to ask for documents or information. Once this process is finished, the Office will acknowledge receipt of a completed application and assign a filing date, that is, the date that your application is officially filed. (Do not confuse this date with registration.) This filing date is particularly important for proposed use trade-mark applications, since it is the date the *Trade-marks Act* deems to be the entitlement date of your trade-mark application.

After the formal filing you may make minor modifications in your application. Major changes, however, would entail the trouble and expense of another filing. To avoid this, you or your agent must take great care in preparing your application.

Search and research

Trade-marks Office staff conduct a thorough search of the records to verify that your trade-mark cannot be mistaken for anyone else's. They also conduct research to determine whether your mark fulfils all the criteria of the *Trade-marks Act*, in other words, that it does not fall into any of the categories discussed in the section, "Making sure your trade-mark can be registered." The results are considered by the Trade-marks Examiner assigned to your case.

Examination

The Examiner studies the data and decides whether your application can be accepted. If there are doubts about your case, the Examiner will notify you in writing of the objections. You then have opportunities to respond. If your answers still fail to satisfy the Examiner, you will receive a letter informing you that your application has been refused and explaining the reasons why. In the event of refusal, you have the right to appeal to the Federal Court of Canada.

Disclaimers

The Examiner may request that the applicant disclaim the right to the exclusive use, apart from the trade-mark, of a portion of the trade-mark.

Abandonment

If you fail to prosecute your application (take all the steps necessary to complete the process), your application may be considered abandoned. Before this happens, you will be notified and given an opportunity to remedy the situation within a specified time period. If you do not respond appropriately, your application will be considered abandoned and you will have to re-apply with the requisite fee to pursue the trade-mark.

Pre-publication search

Let's suppose your application for the trade-mark "Northpole" has been approved for advertisement in the *Trade-marks Journal*. The Examiner could find no grounds to disqualify it. Does that mean registration is completed? No. There are still hurdles to overcome. The Office does another search, called Pre-publication Verification, to ensure that in the intervening months, no one has registered or applied for registration of a trade-mark that conflicts with yours. The Office will again correspond with you if necessary and seek your comments on any such trade-mark.

Advertisement

Suppose the Pre-publication Verification has not unearthed any new objections for “Northpole.” Now your application is ready for advertisement in the *Trade-marks Journal*. This journal, published each Wednesday, contains details about every application which has been approved for advertisement. When an application is advertised, it allows members of the public an opportunity to raise objections to pending applications prior to registration. It is another means of weeding out trade-marks that conflict with those of other owners. The *Journal* entry for “Northpole” is a summary of the information on the trade-mark and includes your name, address, file number, filing date, the trade-mark (the word mark, symbols, etc.), whether it is based on “use” or “proposed use,” which goods and services it is used for and any other claims (colour claims, disclaimers, etc.).

Opposition

Any person with valid grounds for doing so may oppose a trade-mark application advertised in the *Trade-marks Journal*. An opposition must be made within two months of the publication date by either filing a statement of opposition together with a fee of \$250, or by requesting an extension of time to oppose, with a fee of \$50. The Trade-marks Office will dismiss an opposition it considers to be frivolous.

If your application is opposed and you don't already have an agent, you are urged to hire one at this point. The same holds true if you wish to oppose someone else's application. Opposition is a complex adversarial process, much like a court proceeding, during which both parties may file evidence and counter-arguments, cross-examine the evidence of the other party and make representations at an oral hearing. The whole procedure can take as long as two to four years, sometimes longer. After a final decision is rendered, it may be appealed to the Federal Court of Canada. Because opposition proceedings can absorb so much time and money, you are advised to choose your trade-mark agent carefully. Seek someone who has a proven expertise in the field.

Allowance and registration

If there is no opposition, or if an opposition has been decided in your favour, your application will be allowed. The Trade-marks Office will not consider any further challenges. You will receive a Notice of Allowance and be asked to pay the \$200 registration fee. If your application has been based on “proposed use,” you will be asked for a declaration stating you have commenced use of the trade-mark. The final step, after you have fulfilled these requirements, is for the Office to issue a Certificate of Registration and enter the registration on its records.

Assignment

A trade-mark is a form of property. You can sell, bequeath or otherwise transfer your rights to it to another party through a transaction called an “assignment.” You should formally notify the Trade-marks Office of such changes in ownership so that the Office can amend its records accordingly. This is done to avoid ownership disputes.

There are no prescribed forms for notifying the Trade-marks Office of an assignment, but you must send in a legal document attesting to the change, together with the prescribed fee. The original instrument of transfer or a notarized copy should be used.

Other transactions can affect the ownership of a trade-mark, for example a change of name, a merger, etc.

Registered users

As a registered trade-mark owner, you also can license your rights to persons or organizations of your choosing, provided that the licensee is appointed a “registered user” of the trade-mark in accordance with the *Trade-marks Act*. Registered users or licensees may be companies, individuals, partnerships, trade unions or other lawful associations. Suppose you were to franchise Northpole Ice Cream outlets. A significant aspect of the contract with your franchisee would be permission to use the “Northpole” trade-mark.

You and your franchisee would jointly file an application (Form 10) with the Trade-marks Office for registered user status for the franchisee. In the application you would specify the user’s name and address, how the party may use your trade-mark (with which wares and services), the period of permitted use, the standards the user must meet, your right of inspection of the wares and/or services and any other restrictions you may wish to attach. The period of permitted use could be a) indefinite — for the entire period that the trade-mark registration is in force or b) definite — for a limited period.

If you have not yet registered your trade-mark, you could file an application for the registration of a person as a registered user along with your trade-mark application. Both are examined by the Office. The user would not receive approval until your trade-mark is allowed.

If your trade-mark is already registered, the application for registered user goes through an examination process. This is to ensure that the necessary information is on the form and is duly recorded in Trade-marks Office records.

It is then important for both parties to abide by the terms set out in the registered user application. The validity of the trade-mark registration can be put into dispute if the registered user does not abide by the requirements in the registered user application.

An owner or a user who wants to change the terms or cancel the registered user status must notify the Trade-marks Office. The Office will then notify the other party and allow them one month to raise objections. If any are raised, there will be contested cancellations proceedings, which are similar to opposition proceedings as discussed previously under “Opposition.”

Marking requirements

Canada’s *Trade-marks Act* does not contain any marking requirements. However, trade-mark owners often indicate their registration through certain symbols, namely, R in a circle (registered), TM (trade-mark) or MC (marque de commerce). Although the Act does not require the use of these symbols, it is advisable to use them. The symbol TM or MC may be used regardless of whether the trade-mark is registered. The R in a circle, on the other hand, should be used only if the mark is registered.

Canada’s *Precious Metals Marking Act* states that you must file a trade-mark application for the trade-mark used on the wares, if you wish to stamp a quality mark (e.g. 10K gold) on your product. The quality mark itself is not mandatory.

Policing your trade-mark

One of the functions of the Trade-marks Office is to prevent anyone else from registering a mark that is the same as or confusingly similar to your mark. It does not, however, keep an eye out for cases of infringement. It is your responsibility entirely to monitor the marketplace and, if you find someone using your registered trade-mark or a mark or a trade name that is confusing with your mark, to take legal action. Someone who infringes on trade-mark rights may be accountable to you by way of an injunction, i.e. an order to cease the infringing activity and/or damages.

Preventing imitation by competitors is not the only reason to police your mark. If your business is a smash success, your mark may be in danger of becoming a generic term. Believe it or not, too much familiarity can be a bad thing.

If consumers start saying “Northpole” when they mean any ice cream, your trade-mark may no longer be distinguishable from others. Such was the fate of trade-marks such as “Zipper,” “Escalator,” “Cellophane,” and “Dry Ice.” Who remembers that the correct terms are “slide fastener” and “moving staircase”? This is why some companies are very vigilant about policing their marks, and preventing improper use of their trade-marks in any kind of communication.

Before using someone’s trade-mark in communications you must acknowledge the ownership and receive permission.

Information officers at the Trade-marks Office can assist you with questions about trade-marks as well as instructions on searching the NUANS electronic database and other trade-mark indexes. Address your correspondence to:

The Registrar of
Trade-marks
Consumer and Corporate
Affairs Canada
50 Victoria Street
Place du Portage, Phase I
Hull, Quebec
K1A 0C9

or telephone (819) 997-1936
between 8:30 a.m. and 4:45 p.m.,
Eastern Time, Monday through
Friday, except on legal holidays.

To help the Office help you,
please refer to your file number
(if and when you receive one) in
all your written and telephone
communications. Other useful
references to include would be:
trade-mark registration numbers
and, in the case of an opposition,
the date the relevant trade-mark
application appeared in the
Trade-marks Journal, together
with the serial number of the
application.

For copies of the *Trade-marks Act*
and *Regulations*, the *Trade-marks*
Journal, and the *Trade-marks*
Examination Manual, write to:

Supply and Services Canada
Publishing Centre
Ottawa, Ontario
K1A 0S9

There is a fee for each of these
publications.

The following table presents all the possible application, registration and service fees payable to the Registrar of Trade-marks as of July 1, 1985.

PART I

On the filing of:

- 1** An application for registration of a trade-mark\$150
- 2** An application for registration of a person as a registered user of a trade-mark\$100
- 3** An application for registration of a person as a registered user of two or more trade-marks registered in the name of the same owner, where the conditions and restrictions are the same for the use of each trade-mark
 - a) for the first trade-mark....\$100
 - b) for each additional trade-mark.\$25
- 4** An application to cancel the registration of a person as a registered user of one or more trade-marks:
for each trade-mark\$50
- 5** An application to vary the registration of a person as a registered user of one or more trade-marks:
for each trade-mark\$25
- 6** A statement of opposition.....\$250
- 7** An application to amend the registration of a trade-mark by extending the statement of wares or services in respect of which the trade-mark is registered\$300
- 7.1** An application to amend the registration of one or more trade-marks by changing the

address of the registered owner or of his/her representative in Canada\$25

8 Any other application to amend the register:
for each trade-mark to which the application relates\$25

9 A request to recognize the transfer of one or more trade-marks:
for each trade-mark\$50

10 A request to renew the registration of one or more trade-marks:
for each trade-mark \$300

11 A request for dispatch of one or more notices under section 44 or 45 of the Act:
for each notice\$150

12 An application for an extension of time under section 47(1) or 47(2) of the Act for the doing of any one or more acts:
for each act\$50

13 Each certified copy of a registration referred to in section 31(1) of the Act\$50

14 Each certified copy of an application referred to in paragraph 34(c) of the Act ...\$50

15 Any written authorization, drawing or specimen referred to in section 30(1) (other than a specimen to which section 30(2) applies), the filing of which completes an application for registration of a trade-mark that was not complete, as described in section 30, on the date of filing thereof.....\$50

16 A request under paragraph 9(1)(n) of the Act with respect to one or more badges, crests, emblems or marks:
for each badge, crest, emblem or mark\$300

17 A request for transmission of one or more original files to the Federal Court of Canada:
for each file\$80

PART II

For the registration of:

18 A trade-mark, including, without further fee, the issuance of a certificate of registration of the trade-mark..... \$200

PART III

On the issuance of:

19 A certificate of authenticity\$35
plus for each copy certified\$1

20 Any other certificate\$35
plus for each copy certified\$1

21 Copies of or extracts from the register, or copies of certificates or of other documents:
for each file or entrythe greater of
\$2 or 50 cents per sheet

PART IV

Trade-mark agents:

22 On request to enter a name on the register of trade-mark agents.....\$300

23 Examination fee under section 24\$100

24 Annual registration fee under paragraph 25(1)(a) ...\$300

25 Notice fee under section 25(3) \$100

26 Reinstatement fee under section 25(4).....\$100

APPENDIX A – TWENTY COMMON QUESTIONS ABOUT TRADE-MARKS

Q1 What is a trade-mark?

A A trade-mark is a word, symbol or design, or a combination of these, used to distinguish the goods or services of one person or organization from those of others in the marketplace.

Q2 Are there different kinds of trade-marks?

A Yes, there are three basic types. **Ordinary marks** are words and/or symbols that distinguish the goods or services of a specific firm. **Certification marks** identify goods or services which meet a standard set by a governing organization. **Distinguishing guise** identifies the unique shape of a product or its package.

Q3 What is the difference between trade-marks and other forms of intellectual property?

A Trade-marks are only one form of intellectual property that can be protected through federal legislation. The other forms are: **patents**, for new technologies; **copyrights**, for literary, artistic, dramatic or musical works or computer software; **industrial designs**, for the shape, pattern, or ornamentation applied to an industrially produced object; and **integrated circuit topographies**, for the three-dimensional configuration of the electronic circuits embodied in integrated circuit products or layout designs.

Q4 What is the difference between a registered and an unregistered trade-mark?

A A registered trade-mark has been approved and entered on the Trade-mark Register held by the Canadian Trade-marks Office. Registration is proof of ownership. An unregistered trade-mark may also be recognized through Common Law as the property of the owner, depending on the circumstances.

Q5 Why register a trade-mark?

A Registration is direct (*prima facie*) evidence of exclusive ownership across Canada and helps ward off potential infringers. It enables you to more easily protect your rights should someone challenge them since the onus is on the challenger to prove rights in any dispute. The process of registration, with its thorough checks for conflicting trade-marks, will ensure that you are claiming a unique mark, and help you avoid infringement of other parties' rights. A registered trade-mark is a prerequisite for franchising a business.

Q6 Is registration mandatory?

A No, but it is advisable.

Q7 Why hire a trade-mark agent?

A Trade-mark registration can be a complex process; an experienced agent can save you time and money by avoiding pitfalls such as poorly prepared applications and improper research.

Q8 Who can register a trade-mark?

A Companies, individuals, partnerships, trade unions or lawful associations, provided they meet the requirements of the *Trade-marks Act*.

Q9 How long is registration effective?

A Registration is valid for 15 years and is renewable every 15 years afterwards upon payment of a fee.

Q10 How do I register a trade-mark?

A You must file an application with the Trade-marks Office in Hull, Quebec. The application undergoes stringent examination to ensure it meets the requirements of the *Trade-marks Act*.

Q11 Does registration in Canada protect my rights in other countries?

A No. If your products are sold in other countries, you should consider applying for foreign registration. Contact a trade-mark agent or the embassy of the country in question to find out about procedures.

Q12 *What is the difference between a trade-mark and a trade name?*

A A trade name is the name under which you conduct your business. It can be registered as a trade-mark, but only if it is used as such, that is, used to identify wares or services.

Q13 *May I register my own name as a trade-mark?*

A Normally, you may not register a proper name — neither yours, nor anyone else's — as a trade-mark. An exception may be made if you can demonstrate that the name has become identified in the public mind with certain wares or services.

Q14 *What other kinds of marks may not be registered?*

A In general, marks that may not be registered are: words that are clearly descriptive (e.g. "delicious" ice cream), terms that are misleading, words that designate a place of origin (e.g. "Atlantic" cod), terms or symbols that are too similar to an existing trade-mark, and terms and symbols that are expressly prohibited under the *Trade-marks Act*. These latter include symbols (coats of arms, badges, crests, etc.) of national and international organizations and terms that are considered immoral or offensive.

Q15 *What are the steps of trade-mark registration?*

A Trade-mark registration usually involves:

- 1) a preliminary search (done by you or your agent) of existing trade-marks;
- 2) an application;
- 3) examination of your application by the Trade-marks Office;
- 4) publishing of the application in the *Trade-marks Journal*;
- 5) time for opposition (challenges) to the application; and
- 6) allowance and registration (if there is no opposition).

Q16 *Why is the preliminary search important?*

A It helps you determine whether your application has a chance for success. It helps you avoid infringing on other people's trade-marks.

Q17 *Will the Trade-marks Office tell me during my preliminary search if my trade-mark can be registered?*

A No, the Office cannot provide a judgment at this stage. This can only happen during the examination process. Officials will give you general information about the rules and regulations.

Q18 *What do I need to include in my application?*

- A**
- 1) the appropriate, completed application form;
 - 2) your written authorization if someone other than you or your agent has signed the application;
 - 3) the application fee; and
 - 4) any required drawings and specimens.

Q19 *May I allow other parties to use my registered trade-mark?*

A Yes. You may sell, bequeath or otherwise transfer your rights to a trade-mark through a process called assignment. You may also license rights to your trade-mark to parties termed "registered users."

Q20 *Will the Trade-marks Office ensure that my trade-mark is not infringed?*

A The Trade-marks Office does not act as an enforcement agency. You are responsible for monitoring the marketplace for cases of infringement and taking legal action, if necessary.

Format 1

Application for Registration of a Trade-mark in use in Canada

To: The Registrar of Trade-marks, Ottawa, Canada.

The undersigned _____ the full post office address of whose principal office or place of business is _____

_____ hereby applies for the registration, in accordance with the provisions of the *Trade-marks Act*, of the trade-mark identified below.

The trade-mark is the word(s) (or is shown in the attached drawing).

_____ The trade-mark has been used by the applicant in association with all the specific wares listed hereafter, and the applicant requests registration in respect of such wares. The trade-mark has been so used in Canada in association with the general class of wares comprising the following specific wares _____ since _____

and in association with the general class of wares comprising the following specific wares _____ since _____

_____ The trade-mark has been used in Canada by the applicant in association with all the specific services listed hereafter, and the applicant requests registration in respect of such services. The trade-mark has been so used in Canada in association with the general class of services comprising the following specific services _____ since _____

and in association with the general class of services comprising the following specific services _____ since _____

The applicant is satisfied that he or she is entitled to use the trade-mark in Canada in association with the _____ described above.

Executed at _____ this _____ day of _____, 19____.

Telephone No. _____

Format 4

Application for Registration of a Trade-mark

To: The Registrar of Trade-marks, Ottawa, Canada.

The undersigned _____ the full post office address of whose principal office or place of business is _____

_____ hereby applies for the registration, in accordance with the provisions of the *Trade-marks Act*, of the trade-mark identified below.

The trade-mark is the word(s) (or is shown in the attached drawing)

_____ The applicant intends to use the trade-mark in Canada in association with _____

_____ and requests registration of the trade-mark in respect of such wares.

The applicant intends to use the trade-mark in Canada in association with _____

_____ and requests registration of the trade-mark in respect of such services.

The applicant is satisfied that he or she is entitled to use the trade-mark in Canada in association with the _____ described above.

Executed at _____ this
day of _____, 19____.

Telephone No. _____

Abandonment An application for trade-mark registration may be considered abandoned if the applicant does not take steps to complete the process.

Advertisement Publication of a trade-mark application in the *Trade-marks Journal*. Details are published to allow opportunity for challenges to the application (opposition).

Allowance Acknowledgement by the Trade-marks Office that an application is eligible for registration. The applicant receives a "Notice of Allowance" (not the same as "Certificate of Registration").

Assignment Transference of trade-mark rights from the owner to another party.

Canadian Trade-marks Office The federal government agency responsible for registering trade-marks in Canada.

Certification Marks Marks identifying goods or services meeting a defined standard (e.g., Wool Mark on clothing).

Clearly descriptive A word that clearly describes a feature of a product or service and therefore is not registrable as a trade-mark.

Copyright Legal protection for literary, artistic, dramatic or musical works or computer software.

Deceptively misdescriptive A word that may not be registered as a trade-mark or part of a trade-mark because it is misleading.

Disclaimer A statement that a certain word or portion of a trade-mark is not protected.

Distinguishing guise The unique shape of a product or package which can be registered as a trade-mark.

Examination The process through which the Trade-marks Office determines whether an application for trade-mark registration warrants granting registration.

Fees Specific sums payable to the Trade-marks Office for various services.

Filing date The date a completed application is officially received at the Trade-marks Office and filed (not to be confused with registration).

Industrial design a) The shape, pattern or ornamentation (or combination of these) of an industrially produced object. b) Legal protection against imitation of these elements.

Infringement (of a trade-mark) Violation of trade-mark rights through unauthorized use of a trade-mark.

Integrated circuit topography

a) The three-dimensional configuration of the electronic circuits embodied in integrated circuit products or layout designs. b) Legal protection against imitation of this configuration.

Intellectual property A form of creative endeavour that can be protected through a trade-mark, patent, copyright, industrial design or integrated circuit topography.

Opposition The process whereby members of the public may object to the granting of a trade-mark registration if they have valid grounds for doing so.

Patent A government grant giving the right to exclude others from making, using or selling an invention.

Pre-publication verification A second search of Trade-marks Office records to ensure no confusing trade-marks exist before a given application is published in the *Trade-marks Journal*.

Place of origin A word that designates the origin of a product or service and therefore may not be registered as a trade-mark.

Preliminary search The search of Trade-marks Office records one should undertake before submitting an application for trade-mark registration. The search may turn up conflicting trade-marks and show that the application process would be in vain.

Prohibited marks Marks which are specifically prohibited from use through section 9(1) of the *Trade-marks Act*.

Proposed use A statement indicating intention to use a certain trade-mark and how that use will occur.

Registration The granting of formal recognition of a trade-mark by the Trade-marks Office.

Registered user A party that has been authorized to use a registered trade-mark by the mark's owner.

Registered trade-mark A trade-mark entered on the federal government's Trade-mark Register, which formally recognizes the owner's rights to the mark.

Registered trade-mark agent A person who is qualified to be registered under federal legislation as a trade-mark agent. The person is either: a) a lawyer or notary (in Quebec) who has paid a registration fee, or b) someone who has worked, under supervision, in the trade-marks field for a prescribed period and has passed qualifying examinations.

Registrar of Trade-marks The official responsible for the Canadian Trade-marks Office.

Trade-mark A word, symbol or design, or combination of these, used to distinguish the goods or services of one party from those of another.

Trade-marks Act Federal legislation governing trade-mark registration in Canada.

Trade-marks Journal A publication of the Trade-marks Office issued weekly and containing all approved applications and Office rulings.

Trade-marks records The inventory of registered trade-marks and pending applications maintained by the Trade-marks Office at its premises in Hull, Quebec.

Trade-mark Register The official listing of registered trade-marks.

Trade name The name under which a company chooses to operate. Trade names may or may not also be considered trade-marks, depending on the circumstances.

